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CHARLES ELMORE CROPL
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1948.

No. 230

MINNESOTA MINING & MANUFACTURING COMPANY,

Petitioner,

vs.

INDUSTRIAL TAPE CORPORATION,

Respondent.

PETITION FOR THE WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT AND BRIEF IN SUPPORT THEREOF.

GEORGE I. HAIGHT,
HAROLD J. KINNEY,
M. K. HOBBS,
Counsel for Petitioner.

THE DUNTHORP-WARREN PRINTING COMPANY, 210 WEST JACKSON, CHICAGO

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No. .....

MINNESOTA MINING & MANUFACTURING COMPANY,

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vs.

INDUSTRIAL TAPE CORPORATION,

Respondent.

PETITION FOR THE WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

To the Honorable Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

The petition of Minnesota Mining & Manufacturing Company, plaintiff and appellant below, prays the issue of the writ of certiorari to the Circuit Court of Appeals for the Seventh Circuit to review the judgment and decison of that Court. A transcript of the record, including the proceedings in said Circuit Court of Appeals, has been filed herein pursuant to Rule 38.

I.

Summary Statement of Matter Involved.

This is a patent infringement suit brought by petitioner in the District Court of the United States for the Northern District of Illinois, Eastern Division (R. 2). The claims in issue were held invalid and the cause dismissed (R. 455). The judgment was affirmed on appeal (R. 502). The opinion of the Circuit Court of Appeals (R. 494) is based upon that Court's decision of an important question of federal pleading and practice.

The patent in suit (Borden No. 2,221,213; R. 466) relates to a device for dispensing pressure-sensitive adhesive tape, such as the products sold by petitioner and respondent under their respective trade-marks "Scotch" and "Texcel".

An important feature of the patented dispenser is that the tape is cut by bringing the adhesive-bearing surface into contact with the cutting edge, so that, by the act of severing a strip of tape for use, the free end attached to the roll secures itself upon a surface or platform to be held in captive position to be grasped readily for the next severing operation (R. 468, col. 2, lines 19-39 and R. 225).

To show the history of the art (R. 204), the petitioner offered in evidence its early McCarthy dispenser (R. 215, 216; 407, 408). This McCarthy dispenser operated by bringing the back or non-adhesive surface of the tape upwardly against the cutting edge (R. 223). No means were provided to hold the end of the tape captive to be grasped for dispensing the next strip (R. 221-223; 271; 279-281).

The respondent pleaded invalidity of the claims in issue because of a large number of patents, publications, and prior uses (R. 12-14). Respondent's answer made no reference to the McCarthy device (R. 11-16). Respondent

amended its answer during the trial; but still made no reference to McCarthy (R. 30-31). Respondent's expert was not questioned as to McCarthy (R. 309-354). The expert's testimony was confined to the five items of prior art identified at page 310.

Respondent's counsel referred to the McCarthy device as *stupid* and *abortive* (R. 207, 208). It was not until its brief was filed after trial and following the filing of petitioner's brief, that respondent indicated that it intended to rely on McCarthy to invalidate the Borden patent.

Upon appeal, the Circuit Court of Appeals said no useful purpose would be served in discussing or analyzing all of the art, and considered only the unpleaded McCarthy* device as being "the most pertinent prior art" (Opinion, R. 497).

This was followed by the observation (Opinion, R. 498):

> "In the first place, we must notice the contention that the McCarthy device was improperly relied upon by the defendant and the court because it was not pleaded by the defendant."

The Court of Appeals' ruling with respect to this contention was

> "* * * that such unpleaded devices cannot properly be relied upon to show anticipation. (Citing cases.) It does not follow, however, that they may not be relied upon even though not pleaded, to show that the patent in suit is invalid for want of invention over such art." (Opinion, R. 498).

The Court therefore rejected "plaintiff's contention that the McCarthy device may not be properly relied upon to invalidate the patent." (Opinion, R. 498).

In making such ruling the Court referred to Sec. 69, Title 35 U. S. C. (Pleading and proof in actions for in-

* As used herein the term "McCarthy" generically includes the similar Clark dispenser, also referred to by the Circuit Court of Appeals.

fringement); but did not refer to the Federal Rules of Civil Procedure, Rule 8 (requiring the pleading of affirmative defenses); nor to the relationship of the one to the other. (The Statute and pertinent portions of the Rule are reproduced in the Appendix hereto.)

In making such ruling the Court adhered, it said, to its own previous ruling in *Oswell* v. *Bloomfield*, 113 F. 2d 377, 378. Such ruling is in direct conflict with the decisions of other Circuit Courts of Appeals, as exemplified in the following cases, referred to more specifically in the brief attached hereto:

Jorgenson v. *Hawkins*, 14 F. 2d 409, 410, C. C. A. 8, 1926.

Chisholm-Ryder Co. v. *Buck*, 65 F. 2d 735, 736, C. C. A. 4, 1933.

Lunati v. *Barrett*, 104 F. 2d 313, 314, C. C. A. 6, 1939.

The use of McCarthy relied upon by the Court was an unnatural and unintended one, and involved cutting the tape from the adhesive side, and from above the knife (Opinion, R. 499). There is no evidence that this was ever done prior to the Borden invention; much less that it was obvious so to do. All the evidence in the record is to the contrary (R. 240; 272-273).

Because of respondent's characterization of McCarthy as abortive and stupid, because of the respondent's failure to plead McCarthy or to amend its answer to include McCarthy, and because of the silence of its expert in respect to McCarthy, there was no occasion whatsoever for petitioner at the trial to anticipate a defense of lack of invention over or anticipation by McCarthy; less was there any occasion to introduce evidence to controvert such unknown defense.

While it is recognized that questions vital to the individual litigant may not necessarily call for issuance of the writ of certiorari, the practice and procedure invoked in this case illustrate vividly the basic procedural points involved and the questions relating to the application of Sec. 69, Title 35, and Rule 8 of the Federal Rules of Civil Procedure, about which the Circuit Courts of Appeals are in wide disagreement and disharmony.

II.

Jurisdiction.

The grounds of jurisdiction are:

1. The statute under which jurisdiction is invoked is Section 240a of the Judicial Code as amended (28 U. S. C. 347).

2. The opinion and judgment of the Circuit Court of Appeals having been entered on May 6, 1948, and that Court having entertained a petition for rehearing which it denied on June 10, 1948, the time for filing this petition extends until September 10, 1948.

3. Cases believed to sustain the jurisdiction of the Court and to sanction the grant of a writ in this particular case are:

Mumm v. *Decker*, 301 U. S. 168, 169.
Helvering v. *Oregon Mutual Life Ins. Co.*, 311 U. S. 267, 268.
Miles v. *Illinois Central Railroad Company*, 315 U. S. 698, 700-701.
Worcester County Trust Company v. *Riley*, 302 U. S. 292, 296; and
Emil v. *Hanley*, 318 U. S. 515, 517.

III.

Questions Presented.

1. Is it required by the law and rules of pleading that a defendant in a patent infringement suit affirmatively and specifically plead the items of prior art upon which reliance is placed to invalidate the patent in suit for lack of invention?

2. Particularly, in the application of Section 69, Title 35 U. S. C. and Rule 8 of Federal Rules of Civil Procedure, is it required that a defendant in a patent infringement suit affirmatively and specifically plead the items of prior art upon which reliance is placed to invalidate the patent in suit for lack of invention?

IV.

Reasons Relied Upon For the Allowance of the Writ.

1. The opinion and judgment of the Circuit Court of Appeals in holding the patent in suit invalid for lack of invention upon an unpleaded item of prior art decided an important question of federal practice and procedure, particularly in reference to Section 69, Title 35, U. S. C. and Rule 8 of Federal Rules of Civil Procedure, which question has not been, but should be, settled by this Court.

2. The exercise of its supervisory and reviewing powers by this Court will secure uniformity of decision among the United States Circuit Courts of Appeals, since those courts are in conflict on the question whether unpleaded prior art may be used to invalidate a patent.

3. This Court has invoked the writ previously in *Mumm* v. *Decker*, 301 U. S. 168, 171, to answer an analogous ques-

tion and to establish uniformity of pleading in patent cases.

Wherefore, your petitioner prays that this petition be granted.

Respectfully submitted,

GEORGE I. HAIGHT,
HAROLD J. KINNEY,
M. K. HOBBS,
Counsel for Petitioner.

August 13, 1948.

BRIEF IN SUPPORT OF PETITION.

I.

Opinions of the Courts Below.

The District Court did not file an opinion. Its findings of fact and conclusions of law are found beginning at page 452 of the Record. The opinion of the Circuit Court of Appeals for the Seventh Circuit (R. 494) is reported at 168 F. 2d 7, Advance Sheets.

II.

Statement of the Case.

This has already been stated in the preceding petition under point I, which is hereby adopted and made a part of this brief.

III.

Specification of Errors.

1. The Circuit Court of Appeals erred in holding that unpleaded prior art may be relied upon to invalidate a patent for want of invention.

2. The Circuit Court of Appeals erred in holding the patent in suit invalid for want of invention solely over unpleaded prior art.

IV.

Argument.

Summary of Argument.

A. Sections 31 and 32, Title 35, U. S. C. require, among other things, that invention be present in a patent. The absence of any of the requirements of these sections is a matter of affirmative defense.

B. Section 69, Title 35, U. S. C. (Pleading and proof in actions for infringement) and Rule 8, Federal Rules of Civil Procedure require that affirmative defenses be pleaded.

C. There is a conflict among the Circuit Courts of Appeals as to whether unpleaded prior art may be used to invalidate a patent for want of invention.

Point A.

Under Sections 31 and 32, Title 35, U. S. C. for a device to be patentable it must not only be new and useful; but it must exhibit invention. *Cuno Engineering Corp.* v. *Automatic Devices Corporation,* 314 U. S. 84, 90-91, and cases there cited.

The grant of a patent is prima facie evidence of its validity. *Cantrell* v. *Wallick,* 117 U. S. 689. *Smith* v. *Goodyear,* 93 U. S. 486.

Hence the absence of any requirement of Sections 31 and 32 must be established by a defendant. "These are matters of affirmative defense." *Mumm* v. *Decker,** 301 U. S. 168, 171; Moore's Federal Practice, 2nd Ed., Vol. 2, p. 1695.

* Petition for certiorari was granted in *Mumm* v. *Decker* because of a conflict among the federal tribunals as to "pleading in patent suits" in respect to the sufficiency of the complaint, 301 U. S. 168, 169. This petition presents an analogous question of pleading, but in respect to the answer.

Point B.

Paragraph (c), Rule 8, Federal Rules of Civil Procedure requires that a responsive pleading "shall set forth affirmatively" specified defenses "and any other matter constituting an avoidance or affirmative defense." (Paragraphs (b) and (c) of the Rule are set forth in the Appendix hereto.) Invention is one of the statutory requirements for patentability, as set forth under Point A. Lack of invention therefore is an affirmative defense, which must be pleaded, *Mumm* v. *Decker*, 301 U. S. 168, 171.

Section 69 of Title 35 (set forth in the Appendix) requires in parts "Fourth" and "Fifth" that prior inventorship or discovery and prior public use or sale* be specifically pleaded or noticed.

The Circuit Court of Appeals did not refer to Rule 8. In a previous decision that Court had found it unnecessary to decide whether or not Section "69 has been abrogated by Rules 8 and 9." (*Oswell* v. *Bloomfield*, 113 F. 2d 377, 378.) Two district courts have said that the Rule supersedes the statute.

In *Municipal Street Sign Co.* v. *City Street Sign Corp.*, 30 F. Supp. 795, 799, D. C. E. D. N. Y., it was said that the defense of inoperability must be pleaded even though the statute was superseded.

In *Smith* v. *Thompson*, 43 F. Supp. 848, 849, D. C. S. D. Calif., testimony as to prior use was admitted, though the defense was not pleaded, inasmuch as Section 69 was superseded by the Rule.

Thus we have two district courts agreeing that Rule 8 supersedes the statute, but the one concluding that therefore answers in patent suits must be the more definite and

* The McCarthy dispenser was in public use and on sale by the petitioner in 1930 (R. 239), six years before application for the Borden patent in 1936 (R. 466).

the other that the answer may be more general. This Court has not ruled on the question whether the Rule supersedes the Statute, or whether the Rule extends the requirements of the Statute as to affirmative pleading. This is a question of importance to the Courts, to the patent bar, and to patent litigants; and should be resolved by this Court.

Point C.

There is a conflict among the Circuit Courts of Appeals as to whether unpleaded prior art may be used to invalidate a patent for want of invention.

The instant case from the Seventh Circuit permits it, following its own similar decision on a materially different set of circumstances in *Oswell* v. *Bloomfield,* 113 F. 2d 377, 378.

On the contrary the Circuit Court of Appeals for the Eighth Circuit will refer to unpleaded art only to construe a patent, but not to invalidate it. In *Jorgenson* v. *Hawkins,* 14 F. 2d 409, 410, 1926, that Court said:

> "It is true that the patents were admissible in evidence to show the state of the prior art, even though they were not pleaded and no notice given under section 4920. But, when so received, their use in evidence would be limited. Though they could be used to aid the court in construing plaintiff's patent, **they could not be used to defeat its validity.** *Grier* v. *Wilt,* 120 U. S. 412, 7 S. Ct. 718, 30 L. Ed. 712; *Sodemann H. & P. Co.* v. *Kauffman,* 275 F. 593 (C. C. A. 8); *Zip Mfg. Co.* v. *Pusch,* 2 F. (2d) 828 (C. C. A. 8); *Jones* v. *Cyphers* (C. C.) 115 F. 324." (Emphasis supplied.)

The Fourth Circuit follows the Eighth. In *Chisholm-Ryder Co.* v. *Buck,* 65 F. 2d 735, 736, 1933, it is held:

> "It is true, as pointed out in the argument of the complainant in this court, that the prior patents not

set up in the defendant's answer, for instance, the patent to Sanborn, **may not be used to invalidate the patents in suit for want of novelty or invention**; but nevertheless these prior patents may properly be received in evidence to show the state of the art and to aid in the construction of the claims relied upon. *Grier* v. *Wilt,* 120 U. S. 412; *Eachus* v. *Broomall,* 115 U. S. 429; *Morton* v. *Llewellyn,* 164 F. 693." (Emphasis supplied.)

In the Sixth Circuit the rule is the same. In *Lunati et al.* v. *Barrett,* 104 F. 2d 313, 314, 1939, the Court said:

"It was held below that the defendant did not infringe. There was no decision as to validity, since the defendant proved no direct anticipation, failed to give notice of lack of invention as a defense, and was not permitted belatedly to amend. While proof of the state of the art is admissible without notice to aid the court in the construction of the patent, *Dunbar* v. *Meyers,* 94 U. S. 187, 24 L. Ed. 34, it is not clear that invalidity may be adjudicated without affirmatively pleading it unless the patent is void on its face. *Brown* v. *Piper,* 91 U. S. 37, 44, 23 L. Ed. 200. Cf. *Slawson* v. *Grand Street, P. P. & F. R. R. Co.,* 107 U. S. 649, 652, 2 S. Ct. 663, 27 L. Ed. 576. We limit our consideration of the controversy likewise to the question of infringement, * * *."

It is significant to note that in *Oswell* v. *Bloomfield,* the Circuit Court of Appeals for the Seventh Circuit relied upon *Grier* v. *Wilt,* 120 U. S. 412, which decision was also relied upon by the Eighth and Fourth Circuit Courts of Appeals in the immediately preceding cases (*Jorgenson* v. *Hawkins* and *Chisholm-Ryder Co.* v. *Buck*) to reach an opposite conclusion.

Hendy v. *Golden State Miners' Iron Works,* 127 U. S. 370, 375, cited by the Court of Appeals (R. 498) applies to the situation where a patent is void on its face, without reference to any art. It involves a situation similar to that

in *Brown* v. *Piper*, 91 U. S. 37, 44, wherein the Court held the patent "void on its face." Obviously these decisions have no pertinence in a situation such as the present one, where the Court specifically relied upon unpleaded art to invalidate the patent in suit. The *Hendy* decision is not helpful in the present inquiry, nor is it in conflict with *Grier* v. *Wilt*.

The Court observed (R. 498) that the plaintiff (petitioner) itself put the McCarthy device in evidence. This is true, but it is always proper to put into evidence prior commercial devices, as an aid in understanding the invention, and "to aid the Court in construing plaintiff's patent" (*Jorgenson* v. *Hawkins, supra*). But such prior devices, if not pleaded against the patent by the defendant "could not be used to defeat its validity" (*Jorgenson* v. *Hawkins, supra*). The point is that a plaintiff is entitled under the Statute and Rule to know what is to be relied upon to defeat him, in order that he may offer proofs to combat the defense. It is the obvious purpose of the Statute, of Rule 8, and of the Rules as a whole, to prevent surprise and ambush.

Conclusion.

It leads to much confusion in Federal practice to have one rule followed in the Fourth, Sixth, and Eighth Circuits; and a directly contrary rule followed in the Seventh Circuit. Since all of the Federal Courts are controlled by the same Statutes and the same Federal Rules of Civil Procedure, the practice should be uniform.

The necessity and public importance of securing certainty in the application of Rules and Statutes, and uniformity of decision among the Circuits is a cogent reason calling for the exercise by this Court of its supervisory powers, by granting the writ of certiorari and thereafter reviewing and reversing the decision and judgment of the Circuit Court of Appeals.

Respectfully submitted,

George I. Haight,
Harold J. Kinney,
M. K. Hobbs,
Counsel for Petitioner.

APPENDIX.

Title 35, Sec. 69, U. S. Code:

"*Pleading and proof in actions for infringement.*

"In any action for infringement the defendant may plead the general issue, and, having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:

"First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

"Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

"Third. That it has been patented or described in some printed publication prior to his supposed invention or discovery thereof, or more than one year prior to his application for a patent therefor; or,

"Fourth. That he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

"Fifth. That it had been in public use or on sale in this country for more than one year before his application for a patent, or had been abandoned to the public.

"And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the things patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be

pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect. R. S. Sec. 4920; March 3, 1897, c. 391, Sec. 2, 29 Stat. 692; Aug. 5, 1939, c. 450. Sec. 1, 53 Stat. 1212."

Federal Rules of Civil Procedure, Rule 8, General Rules of Pleading:

"(b) *Defenses; Form of Denials.* A party shall state in short and plain terms his defenses to each claim asserted and shall admit or deny the averments upon which the adverse party relies. If he is without knowledge or information sufficient to form a belief as to the truth of an averment, he shall so state and this has the effect of a denial. Denials shall fairly meet the substance of the averments denied. When a pleader intends in good faith to deny only a part or a qualification of an averment, he shall specify so much of it as is true and material and shall deny only the remainder. Unless the pleader intends in good faith to controvert all the averments of the preceding pleading, he may make his denials as specific denials of designated averments or paragraphs, or he may generally deny all the averments except such designated averments or paragraphs as he expressly admits; but, when he does so intend to controvert all its averments, including averments of the grounds upon which the court's jurisdiction depends, he may do so by general denial subject to the obligations set forth in Rule 11.

"(c) *Affirmative Defenses.* In pleading to a preceding pleading, a party shall set forth affirmatively accord and satisfaction, arbitration and award, assumption of risk, contributory negligence, discharge in bankruptcy, duress, estoppel, failure of consideration, fraud, illegality, injury by fellow servant, laches, license, payment, release, res judicata, statute of frauds, statute of limitations, waiver, and any other matter constituting an avoidance or affirmative defense. When a party has mistakenly designated a defense as a counterclaim or a counterclaim as a defense, the court on terms, if justice so requires, shall treat the pleading as if there had been a proper designation."

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CHARLES ELMORE CROPLEY
CLERK

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Petitioner,

vs.

INDUSTRIAL TAPE CORPORATION,

Respondent.

PETITIONER'S REPLY BRIEF IN SUPPORT OF ITS PETITION FOR THE WRIT OF CERTIORARI.

GEORGE I. HAIGHT,
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PERKINS-TRACY PRINTING COMPANY, SAINT PAUL, MINNESOTA
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PETITIONER'S REPLY BRIEF IN SUPPORT OF ITS PETITION FOR THE WRIT OF CERTIORARI.

I.

RESPONDENT'S SUPPLEMENTARY STATEMENT OF MATTER INVOLVED IS IRRELEVANT.

It is a cardinal rule that upon certiorari the Supreme Court reviews only the errors assigned by the petitioner. *Warner Co. v. Independent Pier Co.*, 278 U. S. 85, 91; *Alice State Bank v. Houston Pasture Co.*, 247 U. S. 240, 242; *Crown Cork & Seal Co. v. Gutmann Co.*, 304 U. S. 159, 161.

The questions presented (petition, p. 6) and the errors assigned (Brief in Support of Petition, p. 9) are confined exclusively to issues of pleading and practice.

For this reason petitioner did not discuss the *pleaded* prior art. To have done so would have been irrelevant to the questions presented and the errors urged. Similarly, the respondent's "Statement Supplemental to Petitioner's Summary Statement", five pages in length, is neither material nor germane.

The Circuit Court of Appeals observed "that no useful purpose could be served in discussing or analyzing all of this prior art upon which the (district) court predicted its findings and conclusion" (R. 497); and added that the McCarthy device* was "the most pertinent prior art" (R. 497).

It is because the Circuit Court of Appeals reached its decision *solely* on the consideration of the *unpleaded* McCarthy dispenser, as the most pertinent prior art, that the questions presented by petitioner arise. The review sought is limited to the issue of the right of the Circuit Court of Appeals to give invalidating effect to unpleaded prior art.

For the foregoing reasons the supplemental statement of respondent is irrelevant, and its inclusion is simply confusing.

Petitioner's disposition of the respondent's supplemental statement on the ground of obvious impertinence is not an admission of the accuracy of such supplemental summary.

---

*Just as in our petition, the term "McCarthy" generically includes the similar Clark dispenser.

II.

RESPONDENT PRESENTS NO SOUND REASON AGAINST GRANTING THE PETITION.

Respondent presents points A and B against granting the petition (Br., p. 6), neither of which is sound. Each point is based upon the position that the questions presented are *moot*, different supporting argument being given with each point.

Therefore, if respondent is wrong in its contention that "the questions presented by the petitioner are *moot*", it will be apparent that respondent has presented no reason in opposition to the petition.

Respondent is Wrong in Urging that the Findings of the District Court Render Moot the Questions Here Presented.

To support its argument that the questions presented are moot, the respondent refers to the trial court's findings on the *pleaded* prior art. Respondent says that these findings "were not reversed by the Circuit Court of Appeals". It is careful at this point not to say that they were affirmed, because they were not*. Actually, the Circuit Court of Appeals expressly declined to consider the pleaded prior art (R. 497). Moreover it plainly indicated that the pleaded art was less relevant than the unpleaded McCarthy device. See the Circuit Court's opinion (R. 497):

"... **McCarthy .... (is) are the most pertinent prior art.**"

The fact that the Circuit Court relied solely upon the McCarthy device, when such reliance involved the further question of the propriety of considering it at all, might well be taken as indicating that none of the pleaded art was considered as being sufficiently pertinent to invalidate the patent.

---

*However, at page 1 of its brief, respondent erroneously indicates that there was an affirmance of those findings.

Respondent's statement (Br., p. 6) that the pleaded art is "dispositive of the controversy" at most is a prophecy and speculation as to what the Circuit Court of Appeals would decide were it directed by this Court to determine the merits of the controversy on the pleaded art.

Respondent's argument, in sum, is that if there are other grounds, not considered, upon which the Circuit Court of Appeals *might* have affirmed the judgment of the District Court, then it is a moot question whether that Court was in error on the point or points on which it did decide the appeal. The error of this view is rather self-apparent; and further is demonstrated by this Court's decision in *Crown Cork & Seal Co. vs. Ferdinand Gutmann Company,* 304 U. S. 159.

One of the patents sued upon in that case was Warth Patent, No. 1,967,195 on a method of manufacturing bottle caps. It was held valid and infringed by the District Court for the Eastern District of New York. In making this holding of validity and infringement, the district court discussed eleven prior art patents and held that none of them suggested the possibility of a method such as Warth's. The court also considered a number of alleged prior uses by both the defendant and the plaintiff and held that none of these prior uses invalidated the patent. It also held that there was no *laches* involved in filing the application which resulted in the Warth patent.

Upon appeal to the Circuit Court of Appeals for the Second Circuit, the holding as to the validity of the Warth Patent was reversed and claims 1, 2, and 3 thereof were held invalid solely on the ground of laches in filing the application for them, 86 F. 2d 698, at 702. **There, as here, the Circuit Court made no holding in respect to the pleaded prior public uses or prior art patents.**

The petition for certiorari, granted by this Court, raised only the question of whether the application for the Warth patent was timely filed. The holding of the Circuit Court of Appeals was reversed. This Court held that the Warth patent was not invalid for delay in filing the application; and said, p. 168.

> "As our decision is limited to the first question presented, the judgment of the circuit court of appeals will be reversed and the case will be *remanded* to that court *for decision of the other issues* in the case in accordance with this opinion." (Italics added)

This Court did not there assume that the Circuit Court of Appeals had already decided all the issues raised by the appeal and, contrariwise, recognized that the Circuit Court of Appeals had not reviewed the question of whether the patent there in suit was valid over the pleaded prior public uses and prior art patents.

By analogy to the action taken in the above case, upon deciding the questions here presented, as petitioner asks, this Court would *reverse* the judgment of the Circuit Court of Appeals and *remand* this case to that Court "for decision of the other issues" raised by the appeal.

This completely disposes of respondent's Point A.

Respondent is Wrong in its Position that the Introduction into Evidence of the McCarthy Device by the Petitioner Relieves Respondent of the Need to Plead It Affirmatively in order to Rely upon It as a Defense.

Respondent says that: "Title 35, Sec. 69, U. S. Code, was for the purpose of preventing surprise at the trial" (Br., p. 7). In respect to Rule 8, respondent says that whether it "has superseded that section of the code and requires such matters to be pleaded specially seems

immaterial" (Br., p. 7). Respondent goes on to say that petitioner introduced the McCarthy device itself and argues that, therefore, petitioner was not surprised by the McCarthy device.

The McCarthy device per se did not surprise petitioner *at* the trial. What surprised petitioner was the subsequent *defense* based upon the McCarthy device. It was further surprised by the defense based upon an unintended and non-existent use of McCarthy, without opportunity factually to rebut such defense. *After the conclusion of the trial*, respondent sought, for the first time, to rely upon the McCarthy device as a *defense*, i. e. as invalidating the patent in suit. This *defense* came as a complete surprise to petitioner, especially inasmuch as the McCarthy device was characterized by the respondent during the trial as *stupid and abortive* (R. 207, 208). The *defense* was asserted for the first time when it was too late for petitioner to rebut it with evidence.

The purpose of the statute, and the very clear purpose of Rule 8 which supersedes it, is to prevent a defendant from belatedly raising a surprise defense which it could have and should have pleaded at a time early enough to give the plaintiff a fair opportunity to rebut the defense with any available evidence. Respondent waited to urge McCarthy as a defense until all of the evidence was in, the trial was closed, and the petitioner's brief was filed.

That petitioner did not consider the device to invalidate the patent in suit, is self-evident from the fact that petitioner commenced the suit and introduced the McCarthy device in evidence. The record makes it clear that neither did the respondent initially consider the McCarthy device as negativing invention or otherwise invalidating the patent in suit, for until the trial was completed, it characterized

the McCarthy device as stupid and abortive. Therefore reasonable foresight and prudence on the part of petitioner's counsel during the trial of the case could not have suggested that evidence should have been introduced to meet a defense that the patent in suit was invalid for lack of invention over the McCarthy device. No such defense had been raised in any manner. Less was it raised by the defendant setting it "forth affirmatively" as a defense in its Answer, or in an amendment thereto, as required by Rule 8.

As indicated in our petition and brief, pages 2 and 14, it is always proper for either the plaintiff or defendant to put into evidence prior commercial devices, thereby "to aid the Court in construing plaintiff's patent" (*Jorgenson v. Hawkins*, 14 F. 2nd, 409, 410). The respondent cannot justify a failure to plead a defense based upon a prior art device by pointing out that petitioner knew of the device. It knew of the device, but it knew nothing of a defense based thereon. The statute and Rule 8 do not permit such ambush tactics, whether innocent or not.

Decisions Cited by Respondent Further Demonstrate the Confusion and Conflict Among Circuit Courts of Appeals.

Nowhere does respondent deny that there is a conflict among the circuits as to the effect which may be given to unpleaded prior art.

Nor does respondent deny the importance of a resolution of that conflict.

Instead respondent cites (Br., p. 7) a decision from the Circuit Court of Appeals for the Second Circuit and three from the First Circuit (one of which is from a district court) which emphasize the confusion and conflict.

In the *Dey*[1] case, the defendant argued the unpleaded use without objection from the plaintiff. The same observations apply to the *National Biscuit*[2] case. In the *Swift*[3] case the patent was invalid on its face for insufficiency of disclosure.

In the *Dey* and *National Biscuit* cases the courts referred to the fact that plaintiff was aware of the unpleaded use. However, the statute and the rule make no exception on this ground, and very logically do not. It is obvious that a plaintiff in a patent infringement suit may be aware of hundreds of prior uses, including his own and yet, in the absence of proper pleading on the part of the defendant, not have the slightest idea that any one of them would be relied upon to invalidate the patent in suit.

Hence these decisions indicate only that some courts have erroneously read a non-existent exception into the statute and thus furnish an additional reason for the allowance of the writ.

Moreover, in each of these cases plaintiff knew at the trial that the unpleaded uses were being relied upon as defensive matter. There was no surprise defense. On the contrary, in the instant case every indication was that McCarthy was not to be relied upon. This for the following reasons: (1) Respondent referred to the McCarthy dispenser as abortive and stupid (R. 207, 208). (2) Respondent's expert was interrogated only about the pleaded art, and made no reference to McCarthy (R. 309-345). (3) Respondent amended its answer during the trial, but still made no reference to McCarthy (R. 30-31).

Under these circumstances petitioner could not reasonably anticipate *at* the trial that thereafter, as a further

1. *Dey Time Register v. Bundy Recording Co.*, 178 F. 812, C.C.A. 2.
2. *National Biscuit Co. v. Crown Baking Co.*, 105 F. (2) 422, C.C.A. 1.
3. *M. Swift & Sons v. Coe Mfg. Co.*, 102 F. (2) 391, C.C.A. 1.

defense, McCarthy would be relied upon to deny novelty and invention. Thus petitioner had no reason or opportunity to present witnesses that it was not obvious (as the Circuit Court of Appeals said it was) to use McCarthy (in an unintended and impractical manner) to make of it a Borden dispenser.

Respondent's surprise reliance on McCarthy was prejudicial to plaintiff, and contrary to the intent and purpose of the statute and the rule.

In *Blanchard v. Putnam*, 75 U. S. 420 (cited by respondent at p. 7) this Court refused evidence of an unpleaded prior use because the plaintiff would have no opportunity to meet this defense. In the *Blanchard* case, the defendant's intended use of the refused evidence was apparent. The instant case suggests ambush. Yet it is this decision which respondent cites in support of its statement that the purpose of the statute is to prevent surprise.

The three Supreme Court decisions cited at page 8 of respondent's brief are not in point, since the Circuit Court of Appeals in the instant suit relied solely and specifically on one unpleaded item of prior art to invalidate the patent in suit.

The irrelevance of the *Brown*[1] and *Hendy*[2] cases has already been pointed out in petitioner's brief, pages 13-14.

The language from the *Slawson*[3] case is quoted out of context by respondent. There are other reasons to support the decision reached in the *Slawson* case. Furthermore, surely respondent does not seriously suggest that the arguable inferences which it draws from the *Slawson* decision (rendered in the year 1883) outweigh the direct mandate of Rule 8 to plead all affirmative defenses.

1. *Brown v. Piper*, 91 U. S. 37.
2. *Hendy v. Miner's Iron Works*, 127 U. S. 370.
3. *Slawson v. Grand Street P. P. & F. R. R. Co.*, 107 U. S. 649.

CONCLUSION

Respondent does not deny that conflict and confusion exist among the several Circuit Courts of Appeals on the questions presented in the petition, nor does it deny the importance of resolving that conflict.

The questions raised in the petition are not moot, for the reasons presented above. Hence the only two reasons advanced against the granting of the writ are disposed of.

The petition should be allowed and the writ granted.

Respectfully,

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M. K. HOBBS,
Counsel for Petitioner.

September 20, 1948

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SEP 9 1948

CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1948

No. 230

MINNESOTA MINING & MANUFACTURING COMPANY,
Petitioner,

against

INDUSTRIAL TAPE CORPORATION,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR THE WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT

DRURY W. COOPER,
ARNOLD S. WORFOLK,
HARRY W. LINDSEY, JR.,
Counsel to Respondent.

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Statement Supplementary to Petitioner's Summary Statement of the Matter Involved

The petition and brief of petitioner presents only a partial picture of what was decided in the District Court and affirmed by the Court of Appeals. Accordingly it is essential that a supplementary statement of the matter involved be made.

To show invalidity of the Borden patent in suit, respondent pleaded in its answer and offered evidence at the trial, The Francis Sales Co. dispenser, illustrated in Office Appliance Magazine, published September, 1908 (R. 325, 486), the Shuman patent 1,016,966 (R. 325, 472, 473,

474), the Moore patent 1,687,031 (R. 325, 480 to 485 incl.), the Simmons patent 1,608,344 (R. 325, 476, 477, 478), and the prior use Johnson & Johnson Machine No. 50 for winding tape upon individual cylinders or rolls (R. 39, 422 to 429 incl.).

The District Court found and concluded that the claims in suit were invalid in view of the pleaded prior art and completely anticipated by certain of the prior art disclosures (R. 452, 453, 454).

The Circuit Court of Appeals did not reverse the lower Court's findings with respect to the pleaded prior art. This art is described briefly below:

The Francis Sales Device

This device was designed to dispense gummed paper tape useful in sealing packages. It has a support for a roll of tape, a serrated cutting edge for severing desired lengths of tape, and between the serrated cutting edge and the roll support there is a surface to which the tape adheres in the act of cutting. This surface serves as a moistener when the device is used with gummed tape. Ample space between the surface and the roll support enables the tape to be grasped by the fingers for withdrawal from the roll (R. 310, 311, 312, 313, Finding 9, p. 453).

The Shuman Patent

This patent discloses a device for dispensing gummed adhesive tape. It is blanked out of sheet metal and bent to provide means for supporting a roll of adhesive tape. The tape-supporting means has synclinally disposed end walls to give a two point support to a roll of tape resting

therein. With this arrangement, the tape is prevented from unwinding too freely by the friction exerted at these points of support during the unwinding operation. The Shuman device has a severing edge and a surface positioned between the severing edge and the tape-supporting means to which the strip attaches. A moistening wick is provided since the gummed tape for which it was designed requires moistening. The friction type support in the Shuman device is not suitable for pressure-sensitive adhesive tape, but if it is equipped with a roll-supporting bearing similar to that in the earlier Francis Sales device to hold the roll of tape at the center, there is no difference between it and the device made under the patent in suit (R. 322, 323, 324, 325, Finding 13, p. 454).

Machine No. 50

This is a production machine which was used in the plant of Johnson & Johnson for many years prior to the advent of the Borden dispenser, for winding one-yard lengths of one-half inch and one inch widths of pressure-sensitive adhesive surgeon's tape on spools. In this machine, there is mounted in a standard at the rear, a large supply roll of tape, either one-half inch or one inch in width. The tape comes off the supply roll, passes beneath, and with its non-adhesive side in contact with, a guide roll, and then over, and with its adhesive side in contact with, a measuring wheel or drum whose circumference is a trifle over a yard.

In the peripheral surface of the measuring roll there is a transversely located severing knife and, adjacent and parallel thereto, a finger groove. Between the finger groove and the knife there is a surface to which the leading end

of the tape adheres after each cutting operation to hold the end of the tape in position for ready grasping by the operator.

In the use of the machine, the operator moves the index finger of her left hand along the finger groove and beneath the tape, lifts the end portion of the tape off the surface between the knife and the finger groove, and applies it to a spool which is located on a spindle in front of the measuring roll somewhat above the center thereof. As the machine cycle is inaugurated, the measuring roll and the spool are rotated in synchronism. Tape pulled off the roll at the rear is wound on the spool, and the amount to be wound is determined when the knife in the surface of the measuring roll has moved around to engage an overlying anvil roll and sever the tape. The remainder of the severed yard length continues to wind up on the spool while the leading end of the portion which remains on the measuring roll is brought around to the starting position, ready for the start of the next cycle (R. 37, 38, 39, Finding 12, p. 454).

The Moore Patent

This patent discloses a device designed to dispense zinc oxide plaster which is the pressure-sensitive adhesive surgeon's tape referred to in the Borden patent (R. 314). The Moore device has a shaft to support rolls of adhesive tape of any desired width. The tape is pulled off the roll and over a surface located at the top of the front wall of the device. Directly adjacent the surface at the front is a groove to accommodate a cutting knife. Since the Moore device is designed to cut cloth backed adhesive tape, the cutting knife is somewhat like a razor fastened to a mem-

ber which rides along the groove to cut off the desired length of tape. The knife cooperates with the front edge of the surface, much like the closing of a pair of scissors. The tape that remains after the cutting operation adheres to the surface at the rear of the groove (R. 314, 315. It is a complete anticipation. Finding 11, p. 453).

If another length of tape from the same roll is then desired, all that is necessary is to place the finger under the tape at the rear of the surface to which the tape has adhered, lift the tape off the surface, pull off the desired length and repeat the cutting operation.

The Simmons Patent

This patent discloses a dispenser for dental floss which may be round or flat, like a ribbon (R. 306). A roll of floss is mounted on a spindle inside the glass container. The floss ribbon is threaded up through a hole in the top of the container where it passes through a slit in a gasket-like sealing member. To dispense a piece of floss, the end is grasped and the desired amount pulled out. The floss is then pulled down over a cutting knife and severed. This knife is arranged at the front of the dispenser on the top (R. 320, 321). The slit in the sealing gasket is tight enough to resist unwinding during the severing operation. The floss is not pressure-sensitive and it has resiliency sufficient to make the end readily accessible for the next dispensing operation (R. 308). It left no room for patentability (R. p. 454, Finding 14).

ARGUMENT

Summary of Argument

A. The questions presented by the Petitioner are *moot*; because the Findings of Fact made by the District Court with respect to the Francis Sales Co. device, the Shuman patent, the Moore patent, the Simmons patent and Machine No. 50, and which were not reversed by the Circuit Court of Appeals, are dispositive of the controversy.

B. The questions presented by the petitioner are moot since the items of prior art not pleaded by respondent, but in view of which the patent in suit was held invalid, nevertheless were presented and explained to the Court, and introduced into evidence by petitioner as part of its prima facie case, in an effort to *sustain* the patent.

Point A

Any answer to the questions presented by petitioner for decision by this Court cannot affect the result of this litigation unless this Court also decides that the District Court erred in making the findings it did with respect to the pleaded prior art (R., 453-4). Rule 52(a) of the Federal Rules of Civil Procedure states that

> "* * * Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. * * *."

At the trial, respondent's expert testified to the effect that there are no differences between the Borden dispenser and those of the prior art other than what can be attributed

solely to mechanical skill (R. 312, 313, 325, 315, 316). There is no contradictory evidence in the case but, nevertheless, the plaintiff disputed the evidence of the defendant. Accordingly, there is no basis or reason for this Court to set aside the trial court's findings of invalidity of the Borden patent in view of the pleaded prior art.

Under the circumstances, the "questions" presented become moot.

Point B

The notice to plaintiff as to proof of previous inventions, knowledge or use of the thing patented, required to be given pursuant to Title 35, Sec. 69, U. S. Code, was for the purpose of preventing surprise at the trial, *Blanchard* v. *Putnam*, 8 Wall. 420. Whether or not Rule 8 of the Federal Rules of Civil Procedure has superseded that section of the code and requires such matters to be pleaded specially seems immaterial. The purpose of the requirement, if necessary, is essentially the same.

Under the code section, notice was not required where the prior use relied on was by the inventor or under his license, *American Hide and Leather Splitting & Dressing Machine Co.* v. *American Tool & Machine Co.*, Fed. Cas. No. 302 (1 Fed. Cas. 647, 654), or where such defense was developed on cross examination, *Dey Time Register Co.* v. *W. H. Bundy Recording Co.*, C. C. A. 2, 178 F. 812, 818; *National Biscuit Co.* v. *Crown Baking Co.*, C. C. A. 1, 105 F. 2d 422, 428; *M. Swift & Sons* v. *W. H. Coe Mfg. Co.*, C. C. A. 1, 102 F. 2d 391, 393. Under the same circumstances there should be no requirement of notice even if Rule 8 of the Federal Rules of Civil Procedure has superseded the code section.

Since the prior art McCarthy devices were offered by petitioner to show the state of the art, petitioner cannot complain if the District Court and the Court of Appeals found that Borden had contributed nothing of a patentable nature over McCarthy.

Whether or not respondent was lawfully required to give petitioner notice before or at the trial, of its intention to rely on the McCarthy device to invalidate the Borden patent is beside the point. What is important is the fact that both the District Court and the Court of Appeals did find the Borden patent invalid on the basis of *petitioner's proofs* on its *prima facie* case. The situation here is quite analogous to that in *Brown* v. *Piper*, 91 U. S. 37, *Slawson* v. *Grand Street P.P. & F.R.R. Co.*, 107 U. S. 649, and *Hendy* v. *Miner's Iron Works*, 127 U. S. 370. In all those cases, the patents involved were held invalid for lack of invention by this court, although the defense was not pleaded.

In the *Slawson* case, the Court said at page 652:

> "If letters patent are void because the device or contrivance described therein is not patentable, it is the duty of the court to dismiss the cause on that ground, whether the defense be made or not."

and again at page 654:

> "The facts of general knowledge of which we take judicial notice (*Taylor, Ev.*, Sec. 4, n. 2; *Brown* v. *Piper, ubi supra*) teach us that devices similar to this are as old as the use of reflectors."

In the three Supreme Court cases mentioned, the patents were held void because of the Court's knowledge of the

state of the art. Here too, the Borden patent was held void because of the Court's knowledge of the state of the art at the conclusion of petitioner's *prima facie* proofs.

CONCLUSION

The questions petitioner seeks this Court to pass upon are not material to the controversy because they are moot and because they are unsound. The petition should be denied.

Respectfully submitted,

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(P-4067)